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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/400,708	09/21/1999	MICHAEL L. GOUGH	NEOIP018	3709
7590 10/24/2006			EXAMINER	
PERKINS COIE LLP			VU, THONG H	
101 JEFFERSON DRIVE			ART UNIT	
MENLO PARK, CA 94025-1114			PAPER NUMBER	
			2142	

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/400,708

Applicant(s)

GOUGH, MICHAEL L.

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Claims 1-3,5-8,11-22 have been renumbered as 1-19 are pending.

Response to Amendment

2. Applicant's arguments, see pages 11-15, filed 2/15/06, with respect to the rejection(s) of claim(s) 1-19 under Hasegawa have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hasegawa.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa [6,510,438 B2].

3. As per claim 1, Hasegawa discloses a method for executing an application program associated with an electronic message, comprising:

after an electronic message is received over a network is selected by automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user, wherein the application program is received, at least in part (i.e.: a sample), over the network after the receipt of

the electronic message and as the result of the opening by the user of the electronic message [Hasegawa, the song data or sample attached to the electronic mail is automatically reproduced when the email is opened, col 2 lines 20-35; sends samples of electronic mail data, col 11 lines 60];

automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof [Hasegawa, automatically reproduces MIDI data contained in the electronic mail, col 10 lines 53-65].

4. Claims 12 and 17 contain the similar limitations set forth of method claim 1.

Therefore, claims 12,17 are rejected for the similar rationale set forth in claim 1.

5. As per claim 2, Hasegawa discloses the electronic message is opened by the user by clicking on an identifier of the electronic message in an electronic mail browser [Hasegawa, display the character data and image data and playback button, col 10 lines 53-65; or addressee's mail box, col 10 lines 35-40]

6. As per claims 3,11,14 Hasegawa discloses the application program includes an applet as inherent feature of Web based applications.

7. As per claim 4, Hasegawa discloses the execution of the application program includes a functionality based on the text included with the electronic message [Hasegawa, HTML, col 10 lines 13-34].

8. As per claim 5, Hasegawa discloses the execution of the application program includes streaming video [Hasegawa, image data, col 10 lines 13-34].

9. As per claim 6, Hasegawa discloses the execution of the application program includes outputting an advertisement as inherent feature of email application.

10. As per claims 7,13 Hasegawa discloses at least one code segment resides, at least in part, in a browser software as inherent feature of email application.

11. As per claim 8, Hasegawa discloses the execution of the application program includes the ability to send a new electronic message over the network [Hasegawa, new control program and upgrade version, col 9 lines 10-17].

12. As per claim 10, Hasegawa discloses the application program includes markup language which calls an object-oriented computer language [Hasegawa, HTML, col 10 lines 13-34].

13. As per claims 9,15,16,18,19 Hasegawa discloses the application develops at least one of pictorial, graphic, animated, video and audio display distributed [Hasegawa, audio, text, image, col 10 lines 13-34].

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Gifford et al [6,549,612 B2].

14. As per claim 1, Gifford discloses a method for executing an application program associated with an electronic message, comprising:

after an electronic message is received over a network is selected by automatically retrieving code from a server over a network after an electronic message received over the network is opened for viewing by a user, wherein the application program is received, at least in part, over the network after the receipt of the electronic message and as the result of the opening by the user of the electronic message [Gifford, opening of the email causes the message to be dynamically updated with any new information, col 16 lines 15-35];

automatically executing the application program of the electronic message within the context of the electronic message after the initialization thereof [Gifford, dynamically updated with any new information, col 16 lines 15-35].

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15. Claims 12 and 17 contain the similar limitations set forth of method claim 1.

Therefore, claims 12,17 are rejected for the similar rationale set forth in claim 1.

16. As per claim 2, Gifford discloses the electronic message is opened by the user by clicking on an identifier of the electronic message in an electronic mail browser

[Gifford, message ID, col 10 lines 67]

17. As per claims 3,11,14 Gifford discloses the application program includes an applet [Gifford, applet, col 6 line 37-col 7 line 27].

18. As per claim 4, Gifford discloses the execution of the application program includes a functionality based on the text included with the electronic message [Gifford, HTML, col 6 line 37-col 7 line 27].

19. As per claim 5, Gifford discloses the execution of the application program includes streaming video [Gifford, multimedia PC, Fig 4].

20. As per claim 6, Gifford discloses the execution of the application program includes outputting an advertisement as inherent feature of email application.

21. As per claims 7,13 Gifford discloses at least one code segment resides, at least in part, in a browser software [Gifford, browser, Fig 4].

22. As per claim 8, Gifford discloses the execution of the application program includes the ability to send a new electronic message over the network [Gifford, new control program and upgrade version, col 9 lines 10-17].

23. As per claim 10, Gifford discloses the application program includes markup language which calls an object-oriented computer language [Gifford, HTML, col 10 lines 13-34].

24. As per claims 9,15,16,18,19 Gifford discloses the application develops at least one of pictorial, graphic, animated, video and audio display distributed [Gifford, multimedia PC, Fig 4].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong H. Vu whose telephone number is 571-272-3904. The examiner can normally be reached on 6:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thong Vu
Primary Examiner
Art Unit 2142

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